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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,272	03/09/2001	Philip K. Yu	998000 PA1	6375
30781	7590	09/22/2004	EXAMINER	
PHILIP K. YU 20955 PATHFINDER ROAD SUITE 100 DIAMOND BAR, CA 91765			AU, SCOTT D	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/803,272

Applicant(s)

YU ET AL.

Examiner

Scott Au

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 11-12 and 17 is/are allowed.
- 6) ☒ Claim(s) 3-5, 8-10 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/9/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

The application of Yu et al. for a "Universal remote control with digital recorder" filed March 9, 2001 has been examined.

Claims 1-17 are pending.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: Referring to the second last line of claim 1, "a power supply located within said housing being", the word "being" is redundant. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Nowhere in the specification as originally disclosed, is described the limitation that "a digital voice recorder" is within a URC together with a scratch pad memory device as claimed in claim 14. According to the specification (i.e. page 8 lines 21-29),

instead of using a digital voice recorder, a scratch pad memory is used. This limitation of claim 14 contains new matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5,13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cullimore (US# 5,214,422) in view of Crowell (US# 5,387,108).

Referring to claim 3, Cullimore discloses a universal remote control ("URC") (14) (i.e. remote control transmitter) to control at least one electronic appliance (20) (i.e. control apparatus) (col. 3 lines 20-31; see Figure 1), comprising:

a housing (94,96) (i.e. support members);

a first control circuitry (i.e. see Figure 6) which, responsive to a user's command, remotely controls the operation of the at least one electronic appliance, the first control circuitry (i.e. see Figure 6) being located within the housing (94,96) (i.e. support members) (col. 3 lines 20-43, col. 6 lines 46-60 and col. 7 lines 2-23; see Figures 1,4-6).

However, Cullimore did not explicitly disclose specifically of that a digital voice recorder, which records and plays back said audio signal, responsive to a user's command; and couple means to attach the digital voice recorder to the housing.

In the same field of endeavor of voice recording device for use independently or in cooperative relationship with alternate products, Crowell teaches a digital voice recorder (20) (i.e. an audio message delivery system), which records and plays back said audio signal, responsive to a user's command (30) (i.e. switch means); and couple means (36) (i.e. elongated tap) to attach the digital voice recorder to the housing (col. 2 lines 20-46 and col. 5 lines 33-68) in order to play the message whenever is desired.

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to include an audio message delivery system, disposed within the housing, which records and plays back said audio signal, responsive to a user's command; and elongated tab to attach the audio message delivery system to the housing disclosed by Crowell into remote control of Cullimore with the motivation for doing so would allow convenience for the user to record surrounding sound and voice signal. Crowell further discloses loop type fastening (col. 7 lines 55-60) as a coupling means and Cullimore discloses Velcro, which is hook and loop fastener (col. 6 lines 61-64). One skilled in the art understands that the remote control and voice recorder are separated devices. Therefore, the remote control and voice recorder devices are operated independently of each other and can be coupled together with coupling means.

Referring to claims 4 and 13, Cullimore in view of Crowell disclose a universal remote control of claim 3, Crowell discloses wherein the digital voice recorder comprises: a microphone (27) (i.e. microphone) to receive the audio signal from both the user and the user's ambience; a processor (25) (i.e. integrated circuit chip) to process the received audio signal from said microphone (27); a memory (25) (i.e. memory is within integrated circuit chip) to store the processed received audio signal, said memory and said first control circuitry being operational independent of each other; a speaker (28) (i.e. speaker) to play back the audio signal, a power supply (26) (i.e. power means), and a second control circuitry (24) (i.e. of printed circuit board) to operate the digital voice recorder upon the user's command (col. 5 line 33 to col. 6 line 25; see Figure 1). Also, as stated in the independent claim 3 above, that one skilled in the art understands that the remote control and voice recorder are separated devices. Therefore, the remote control's circuitry and voice recorder's circuitry are operated independently of each other.

Referring to claim 5, Cullimore in view of Crowell disclose a universal remote control of claim 3, Cullimore disclose a couple means includes a Velcro fastener between a housing (92) (i.e. a base station) and remote controls (98, 100 and 102) (col. 6 lines 61-63; see Figure 5).

Referring to claims 16, Cullimore in view of Crowell disclose a universal remote control of claim 4, Cullimore in view of Crowell stated in the independent claim 3 above,

that one skilled in the art understands that the remote control and voice recorder are separated devices. Therefore, the remote control's circuitry and voice recorder's circuitry are operated independently of each other.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cullimore (US# 5,214,422) in view of Crowell (US# 5,387,108) as applied to the claim 4 above, and further in view of Yoshida et al. (US# 6,256,354).

Referring to claim 10, Cullimore in view of Crowell and disclose a universal remote control of claim 4 above. However, Cullimore in view of Crowell and did not explicitly disclose wherein the memory includes a first-in first-out ("FIFO") memory to store a plurality of signals; memory control to selectively fast-forward, reverse, erase, playback, make permanent at least one of the plurality of the signals stored by the FIFO memory.

In the same field of endeavor of voice recording and playback phone system, Yoshida et al. disclose wherein the memory includes a first-in first-out ("FIFO") memory to store a plurality of signals; memory control to selectively fast-forward, reverse, erase, playback, make permanent at least one of the plurality of the signals stored by the FIFO memory (col. 8 lines 20-43) in order to allow the user to playback at a remote location.

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to have add that wherein the memory includes

a first-in first-out ("FIFO") memory to store a plurality of signals; memory control to selectively fast-forward, reverse, erase, playback, make permanent at least one of the plurality of the signals stored by the FIFO memory of system disclosed by Yoshida et al. into the system of Cullimore in view of Crowell with the motivation for doing so would allow the plurality of signals stored.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of August et al. (US# 5,671,267) in view of Klausner et al. (US# 4,117,542).

Referring to claim 8, August et al. disclose a universal remote control (URC) to control at least one electronic appliance, comprising:

- a housing (10) (i.e. see Figure 3);
- a plurality of keys(360) (i.e. keypad) on the housing, comprising a set of numerical keys corresponding to the numerals "0" through "9" (i.e. see Figure 3);
- a control circuitry (110, 360,125,127,129,130) (i.e. components within the circuitry to remotely control the television) which, responsive to a user's pressing of keys, remotely controls the operation of the at least one electronic appliance, the control circuitry being located with the housing (col. 4 lines 27-40 and col. 5 lines 55-67; se Figures 1-3 and 5).

However, August et al. did not explicitly disclose a scratch pad memory which selectably stores the numerical keys entered by the user, said scratch pad memory



being selectably operationally independent of the operation of said electronic appliance;  
a display on the housing to display the numerical keys entered by the user.

In the same field of endeavor of storing phone numbers electronic device, Klausner et al. disclose a scratch pad memory (col. 14 lines 18-22) which selectably stores the numerical keys entered by the user; a display on the housing to display the numerical keys entered by the user (col. 2 lines 6-22) at a later time.

One of ordinary skill in the art understands that scratch pad memory of Klausner et al. is desirable in the communication device of August et al. because August suggest a remote with keypad which capture audio or visual information and store in memory for the viewer (col. 4 lines 1-27) for later use as desired and Klausner et al. suggest a numeric keys information are stored in scratch pad memory and can be retrieve and display at a later time (col. 2 lines 6-22 and col. 14 lines 18-22). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to include a scratch pad memory which selectably stores the numerical keys entered by the user; a display on the housing to display the numerical keys entered by the user of Klausner et al. in the communication device of August et al. with the motivation for doing so would allow convenience for the user to record the pressed numeric key inputs in memory for later used. One skilled in the art understands that the remote control and the numeric keys recording device are separated devices. Therefore, the remote control and scratch pad memory of the numeric keys recording device are operated independently of each other.

Referring to claim 9, August et al. in view of Klausner et al. disclose the URC of claim 8, Klausner et al. disclose further comprising: a scratch pad control which, responsive to the user's command, selectably activates the scratch pad memory to store, and to recall using said display, the numerical keys entered by the user as a telephone number, independent of the operation of said control circuitry (col. 2 lines 6-22 and col. 14 lines 18-22). . One skilled in the art understands that the remote control and the numeric keys recording device are separated devices. Therefore, the remote control and scratch pad memory of the numeric keys recording device are operated independently of each other.

### ***Claim Objections***

Claims 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Referring to claim 6, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that a couple mean includes an elastic band wrapping around the housing.

Referring to claim 7, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that a couple means includes at least one pair of clamps to attach the digital voice recorder to the housing.

***Allowable Subject Matter***

Claims 1-2, 11-12 and 17 are allowed.

Referring to claim 1, the following is a statement of reasons for the indication of allowable subject matter: the prior art fails to suggest limitations that "a power supply located within said housing being, said power supply being adapted to provide power to said first control circuitry and said digital voice recorder".

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grube et al. (US# 5,201,067) disclose a personal communication device having remote control capability.

Krisbergh et al. (US# 5,138,649) disclose a portable telephone handset with remote control.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Au whose telephone number is (703) 305-4680. The examiner can normally be reached on Mon-Fri, 8:30AM – 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached at (571) 272-3068. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-3906.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

Scott Au



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